

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First named inventor: Douglas F. Libra

Docket No. 00-348

Serial No.10/008,234

Filed: 11/7/2001

Examiner: Jonathan G. Sterrett

Art Unit: 3623

Title: SYSTEM AND METHOD FOR COLLABORATIVE
ACTION

Confirm. No. 6984

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO NOTICE OF NON-COMPLIANT AMENDMENT
DATED JUNE 3, 2009

A non-final office action was mailed on Oct. 9, 2009, and a response was filed on Feb. 9, 2009. The response cancelled all pending claims and added new claims 39-46.

The Notice of Non-Compliant Amendment alleges that the response filed Feb. 9, 2009 is non-responsive because the new claims are patentably distinct from the previously presented claims. Thus, the office action implies that the new claims are (1) subject to restriction, and (2) drawn to a non-elected invention.

The undersigned is pleased to learn that the new claims are patentable over the cancelled claims. Presumably, the new claims are also allowable over the documents made of record.

As for the restriction requirement, the office action has not established a prima facie showing for restriction of the new claims. MPEP 803 states

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent or distinct as claimed; and

(B) There would be a serious burden on the examiner if restriction is not required.

The office action has not made a showing to support either criterion. MPEP 803 states "Examiners must provide reasons and/or examples to support conclusions." However, the office action provides no reasons or examples to show serious burden. For instance, the office action does not provide appropriate explanation of separate classification, or separate status in the art, or a different field of search.

The office action provides no reasons as to why the inventions of claims 38-46 are distinct from the previous presented claims. According to MPEP 802.01

Related inventions are distinct if the inventions *as claimed* are not connected in at least one of design, operation, or effect (e.g., can be made by, or used in, a materially different process) and wherein at least one invention is PATENTABLE (novel and nonobvious) OVER THE OTHER (though they may each be unpatentable over the prior art).

Consider claim 1. The office action does not explain why new claim 39 and previously presented claim 1 are not connected in at least one of design, operation, or effect, nor does it explain why new claim 39 is patentable over claim 1.

Thus, the restriction of new claims 39-46 should be withdrawn. New claims 39-46 should be examined.

Nevertheless, claim 1 has been presented and amended in order to avoid a continued holding of non-responsiveness. A corrected amendments section and a corrected remarks section follow. The corrected amendments section presents claim 1 as well as the new claims 39-46.

The corrected remarks section addresses the rejections of claim 1. And it still argues that the new claims are allowable over the documents made of record.

A petition for a ONE month extension of time is included. The office action set a ONE month shortened statutory period for response. The extended period for response expires on August 3, 2009.

Respectfully submitted,

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